UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,479	01/28/2004	Mikko K. Makela	037145-1101	5071

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EXAMINER
TERMANINI, SAMIR

ART UNIT	PAPER NUMBER
2178	,

MAIL DATE	DELIVERY MODE
10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/767,479	MAKELA, MIKKO K.
	Examiner	Art Unit	
	Samir Termanini	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 July 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *N/A*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

BACKGROUND

1.   This Final Office Action is responsive to the following communications: Amendment filed on 7/31/3007.

2.   Claims 1-48 are pending. Claims 1, 10, 20, 30 and 40 are independent in form. Claims 1, 8, 12, 14, 17, 20, 22-23, 30 and 40 are currently being amended.

RESPONSE TO AMENDMENT

3.   Amendments (filed on 7/31/3007) to claims 40-48 have overcome the Examiner's Rejections of under 35 U.S.C. §101 made in the previous Office Action (Mail dated: 5/1/2007), thus, they are withdrawn.

4.   Arguments (filed on 7/31/3007) concerning the Examiner's Rejections of claims 1-48 made under 35 U.S.C. §102(e) in the previous Office Action (Mail dated: 5/1/2007) have been fully considered but not persuasive. The rejections are being maintained.

5.   Amendments (filed on 7/31/3007) to claims 8 and 12 concerning the Examiner's Objections for typographical errors made in the previous Office Action (Mail dated: 5/1/2007) have been fully considered but are moot in view of the new ground(s) of rejection necessitated by Applicants amendment.

CLAIM REJECTIONS-35 U.S.C. §102

6.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office

action:

> A person shall be entitled to a patent unless-(b) the invention
> was patented or described in a printed publication in this or a
> foreign country or in public use or on sale in this country, more
> than one year prior to the date of application for patent in the
> United States.

7.   **Claims 1-48** are rejected under 35 U.S.C. 102(b) as being anticipated by

Peter *Vale* (PG-Publication 2002/0041291. hereinafter "*Vale*").

I.   Citation of Prior Art

A reference to specific paragraphs, columns, pages, or figures in a cited prior art

reference is not limited to preferred embodiments or any specific examples[1]. It is well

settled that a prior art reference, in its entirety, must be considered for all that it

expressly teaches and fairly suggests to one having ordinary skill in the art[2]. Stated

differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be

ignored on the ground that other embodiments disclosed were instead cited. Therefore,

the Examiner's citation to a specific portion of a single prior art reference is not

intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure

commensurate with the specific limitations being addressed.

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[1] In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968).
[2] *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F.2d

II.   Prior Art Anticipation of Claimed Limitations.

As to independent **claim 1**, *Vale* describe(s): A method for selecting a file from a file list ("...choosing one item and only one item from a group or list of items...," para. [0049]), the method comprising the steps of: determining if there was a file previously selected from the file list ("...that was previously chosen ...," para. [0055]); determining if there is a next file listed relative to the previously selected file in the file list ("...interactive element based on the received direction input relative to a previously selected interactive element ...," para. [0058]); and displaying the file list with the next file highlighted ("...the highlighting from a previously selected interactive element and highlighting (944c) the next selected interactive element ...," para. [0065]).

As to dependent **claim 2**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is listed immediately after the previously selected file in the file list ("...to a previously selected interactive element .... ," para. [00651).

As to dependent **claim 3**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is listed a predetermined number of files after the previously selected file in the file list ("...the amount of vertical separation between interactive elements ...," para. [0043]).

As to dependent **claim 4**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is listed immediately before the previously

792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti,* 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Bozek,* 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

selected file in the file list C... the previously selected interactive element is selected 352 .... ," para. [0041]).

As to dependent **claim 5**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is listed a predetermined number of files before the previously selected file in the file list ("...element at the next vertical level in the direction of direction input 320 that is closest in the horizontal direction to the beginning of the previously selected...,"para. [0041]).

As to dependent **claim 6**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is the file listed immediately to the left ("...left arrow 556...,'.' para. [0049]), right ("...right arrow 554...," para. [0049]), up ("...up...," para. [0061]), or down of the previously selected file in the file list ("...down arrow in a single line textbox...," para. [0061]).

As to dependent **claim 7**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is the file listed a predetermined number of files to the left ("...left arrow 556...," para. [0049]), right ("...the horizontal direction ...," para. [0065]), up (), or down of the previously selected file in the file list ("...previous item in the list ...," para. [0049]).

As to dependent **claim 8**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 wherein the next file is the file listed immediately in front of or behind the previously selected file in the file list C... amount that Element 3 overlaps with Element 1...," para. [0043]).

As to dependent **claim 9**, which depends from claim 1, *Vale* further disclose(s):
The method of claim 1 wherein the next file is the file listed a predetermined number of
files in front of or behind the previously selected file in the file list ("...overlaps with ...,"
para. [0043]).

As to dependent **claim 10**, which depends from claim 1, *Vale* further disclose(s):
The method of claim 1 wherein the next file is a file listed on an immediately preceding
or following screen full of information ("...the interactive element exceeds the width of
available display area...," para. [0058]).

As to dependent **claim 11**, which depends from claim 1, *Vale* further disclose(s):
The method of claim 1 wherein the next file is the previously selected file in the file list
("...the first interactive element relative to the beginning of the content...," para.
[0044]).

As to dependent **claim 12**, which depends from claim 1, *Vale* further disclose(s):
The method of claim 1 further comprising the step of: if there was not a file previously
selected from the file list ("...selecting...," para. [0058]), displaying the file list with a
predetermined default file highlighted ("...an interactive element based on the received
direction input relative to a previously selected interactive element or, if no interactive
element has been previously selected, based on the direction input relative to the
beginning of the displayed content....," para. [0058]).

As to dependent **claim 13**, which depends from claim 12, *Vale* further disclose(s):
The method of claim 12 wherein the predetermined default file is the first file in the file

list ("...the first interactive element relative to the beginning of the content...," para. [0044]).

As to dependent **claim 14**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 further comprising the step of: if "there is not a next file listed relative to the previously selected file in the file list ("...the beginning of the previously selected interactive element is selected next...," para. [0046]), displaying the file list with a predetermined default file highlighted ("...is highlighted...," para. [0044]).

As to dependent **claim 15**, which depends from claim 14, *Vale* further disclose(s): The method of claim 14 wherein the predetermined default file is the first file in the file list ("...unless no interactive element has been selected previously, wherein the interactive element closest to the beginning of the content is selected (not shown)...," para. [0041]).

As to dependent **claim 16** which depends from claim 14, *Vale* further disclose(s): The method of claim 14 wherein the predetermined default file is the previously selected file from the file list ("...unless no interactive element has been selected previously, wherein the interactive element closest to the beginning of the content is selected...," para. [0041]).

As to dependent **claim 17**, which depends from claim 1, *Vale* further disclose(s): The method of claim 1 further comprising the step of in response to a user selecting a file from a file list ("...multiple line textbox ...;" para.. [0060]), saving the information identifying the selected file ("...An act of switching (953) from navigation mode to edit

mode upon receiving an action input also may be included as part of a step from changing (950) the mode of a browsing system .... ," para. [0060]).

As to dependent **claim 18**, which depends from claim 17, *Vale* further disclose(s): The method of claim 17 wherein the saved information is the file name of the selected file,(See Fig. 4).

As to dependent **claim 19**, which depends from claim 17, *Vale* further disclose(s): The method of claim 17 wherein the saved information is an index number of the selected file in the file list ("...interactive elements in numerical order...," para. [0045]).

As to **claims 20-29**, these claims differ from claims 1-19, in that they are "means for" directed to a system for carrying out the processes of claims 1-19. Accordingly, claims 20-29 are rejected for the same reasons set forth in the treatment of claims 1-19.

As to **claims 30-36**, these claims differ from claims 1-19, in that they are directed to a system for carrying out the processes of claims 1-19. Accordingly, claims 20-29 are rejected for the same reasons set forth in the treatment of claims 1-19.

As to dependent **claim 37**, which depends from claim 30, *Vale* further disclose(s): The device of claim 30 wherein the device further comprises a mobile communication device ("...mobile/hand-held devices...," para. [0027]).

As to dependent **claim 38**, which depends from claim 30, *Vale* further disclose(s): The device of claim 30 wherein the device further comprises a mobile telephone ("...wireless telephones...," para. [0027]). As to dependent **claim 39**, which depends from claim 30, *Vale* further disclose(s): The device of claim 30 wherein the device further

comprises a personal digital assistant ("...personal digital assistants PDAs")...," para.

[0027]).

As to **claims 40-48**, these claims differ from Claims 1-19, in that they are

directed toward a product by process. Accordingly, claims 40-48 are rejected for the

same reasons set forth in the treatment of claims 1-19.

RESPONSE TO ARGUMENTS

8.   Applicant arguments, see pp. 11 filed 7/31/3007, with respect to the 35

U.S.C. §102(b) Rejections cited by the Examiner in the previous Office Action (Mail

dated: 5/1/2007), have been fully considered but are not persuasive. Therefore, the

rejection(s) have been maintained..

Applicant argues:

> ...with the navigation mode explicitly involving the use of a direction key
> by the user. It is only through the use of this direction key that
> subsequent items or files are selected and/or highlighted. This is
> discussed clearly in paragraph [001 O] of Vale,...

(pg. 11, Applicant REMARKS). Applicant continues to remark:

> Similarly, the highlighting of the next selected interactive element, as
> identified by the Examiner in paragraph [0065], also occurred only after
> and in response to the receipt of a specific direction input 934c (see also
> Fig. 9C).

(pg. 12, Applicant REMARKS).

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant

relies (i.e., explicitly involving the use of a direction key, occurring only after and in

response) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues:

> Still further, claims 19, 27 and 46 each describe the saving of an index
> corresponding to a selected file in the file list. This feature is entirely
> absent from Vale. In rejecting these claims, the Examiner relied upon
> paragraph [0045], but this section says nothing about saving an index
> number of a selected file or item.

(pg. 13, Applicant REMARKS).

In response to applicant's argument, the Examiner is reproducing para. [0045]:

> [0045] Left and right direction input will select interactive elements in
> **numerical order**, either ascending for right direction input or
> descending for left direction input. Up and down direction input is
> somewhat more complicated. Beginning with Element 1, down direction
> input selects interactive elements in the following **order:** Element 1,
> Element 4, Element 6, Element 7. Beginning with Element 7, up
> **direction** input selects interactive elements in reverse order: **Element 7,**
> **Element 6, Element 4, Element 1.**

(para. [0045]).(emphasis added). Among the other anticipatory examples, here, the

index "Element 7, Element 6, Element 4, Element 1," is discussed with respect to its

ordered traversal.

CONCLUSION

9.   All prior art made of record in this Office Action or as cited on form PTO-

892 notwithstanding being relied upon, is considered pertinent to applicant's disclosure.

Therefore, Applicant is required under 37 CFR §1.111(c) to consider these references

fully when responding to this Office Action.

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date
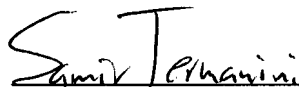
of this final action.

11.   Any inquiry concerning this communication or earlier communications

from the Examiner should be directed to Samir Termanini at telephone number is (571)

270-1047. The Examiner can normally be reached from 9 A.M. to 6 P.M., Monday

through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.
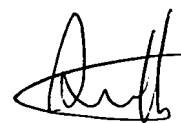
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SUPERVISORY PATENT EXAMINER